

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITSUNOBU ENOMOTO, NOBUO KUCHIKI, YUJI HASE,
YOSHINORI HAMA, TAKASHIGE WAKAMATSU
and MASASHI YAGI

Appeal 2007-1042¹
Application 09/393,576
Technology Center 2100

Decided: April 11, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and JOSEPH L. DIXON, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 23 through 31. We have jurisdiction under 35 U.S.C. 6(b), § 134(a).

¹ Appellants' representative was informed that attendance at the Oral Hearing set for April 5, 2007 was optional due to the above-noted panel's determination to reverse the outstanding rejections of the claims on appeal. This was communicated to the Appellants representative by telephone on April 4, 2007.

Representative independent claim 23 is reproduced below:

23. An internet information displaying method for receiving internet information, displaying it on the screen, and displaying a tool bar composed of plural buttons each representing control function on the screen, comprising steps of:

selecting an arbitrary button in said tool bar; and

magnifying only said selected button into a predetermined size in longitudinal and lateral directions and displaying said selected, magnified button.

The following references are relied on by the Examiner:

Gasperina	US 5,491,781	Feb. 13, 1996
Schindler	US 5,675,390	Oct. 7, 1997
		(filed Jul. 17, 1995)
Austin	US 5,898,819	Apr. 27, 1999
		(filed Jun. 5, 1996)

Claims 23 through 31 stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 23 through 27, 30 and 31, the Examiner relies upon Austin in view of Gasperina, with the addition of Schindler as to claims 28 and 29.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

We reverse.

Each of independent claims 23 and 29 recite in part:

selecting an arbitrary button in said tool bar; and

magnifying only said selected button into a predetermined size in longitudinal and lateral directions and displaying said selected, magnified button.

Corresponding features are recited at the end of independent claim 30 on appeal by requiring the selecting step and reciting “magnifying, in longitudinal and lateral directions, and displaying the selected button upon a single user action.”

We do not agree with the Examiner’s view expressed at the top of page 4 of the Answer that Austin discloses magnifying and displaying a selected button based upon the enlarged view of the button 58 shown in figure 2b in Austin further illustrating the same button in figure 2a. This black and white preview button 58 in figure 2b is merely enlarged for illustration purposes. There is no teaching in Austin that the mere selection of this button in the display of figure 2a causes it to be enlarged or otherwise magnified to the extent recited in each independent claim on appeal. In these respects, therefore, we agree with Appellants’ views expressed at pages 8 and 9 of the principal brief on appeal as to this reference.

The Examiner also takes the view at page 4 of the Answer that Gasperina discloses magnifying a button into a predetermined size in

longitudinal and lateral directions. Inasmuch as the Examiner has not clarified in the Answer the Examiner's positions with respect to this reference, it appears clear to us and Appellants that the Examiner is viewing the teachings of the scroll box 16, 18 (each of which forms part of respective horizontal and vertical scroll bars 20, 22) in the various figures as corresponding to a tool bar button claimed as well as taught in Austin. Gasperina teaches the ability to select a portion of a graphical image for viewing and then to further select the scale of the viewed portion of that image. The various portions of figures 1 and 2 illustrates this.

The various portions of figures 1 and 2 of Gasprina additionally illustrate that the particular scroll boxes 16, 18 may have their respective ranges modified by dragging respective handles 28, 30, 36 and 38 to various positions, thus effectively in part teaching the magnification of the tool box itself within the respective scroll bars 20, 22.

Even if we consider that it would have been obvious for the artisan to have modified Austin with the teachings of Gasprina, the result would not have been the claimed invention as recited in the noted feature of each independent claim on appeal. Effectively changing the length of scroll box 16, 18 and the scroll bars 20, 22 of Gasprina would not have resulted in the claimed longitudinal and lateral direction magnification of a corresponding button of a tool bar but only the magnification of respective scroll boxes 16, 18 in the horizontal or claimed lateral direction. The claimed longitudinal or vertical direction of the selective button in effect would not have been altered in any manner according to the combination because Gasprina fails

to teach this capability. Nor do we believe that this reference even suggests this capability to the artisan.

More fundamentally, however, we also conclude that it would not have been obvious for the artisan to have modified Austin's teachings by those in Gasprina. We simply do not agree with the Examiner's reasons of combinability initially expressed at page 4 of the Answer, i.e., the Examiner's rationale that the resulting combination would have varied the portion of a display and enabled the user to select the scale of a displayed portion. This reasoning is misplaced because both references teach modifying a displayed image according to the respective teachings, as correctly reasoned by the Examiner, but it is the claimed invention that requires magnification or changing of a selected button from a tool bar. Notwithstanding the showing in Austin's figure 2b of an enlarged view of black and white preview button 58, there is no teaching of actually enlarging it in Austin. In the absence of a compelling teaching in Gasprina of applying the teaching value of modifying scroll boxes from Gasprina's scroll bar to the illustrated buttons of a tool bar as in Austin, the combination appears to be based upon hindsight or mere conjecture, neither of which is sufficient to convince us that the artisan would have found it obvious to have combined the selective teachings of the references. Furthermore, as indicated earlier, even if the combination were proper, the result would not have yielded the claimed invention in each independent claim.

Appeal 2007-1042
Application 09/393,576

In view of the foregoing, the decision of the examiner rejecting the claims on appeal is reversed.

REVERSED

PGC

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